

## REMARKS

As a preliminary matter, the Abstract of the invention stands objected to for informalities. Applicants wish to point out to the Examiner that a majority of the Examiner's cited informalities have already been corrected in Supplemental Amendment C, filed September 9, 2003. Specifically, of the 22 cited informalities in the outstanding Office Action (Paper No. 23), numbers 1, 5-8, 10-13, 15, and 17-22 were all amended in Supplemental Amendment C. Applicants will gladly furnish the Examiner with a courtesy copy of Supplemental Amendment C, along with the return postcard from the Patent Office showing that the documents were received thereby, in the event that this document has been misplaced by the Patent Office. With respect to the remaining cited Abstract informalities, namely, numbers 2-4, 9, 14, and 16, Applicants have amended the Abstract according to the Examiner's suggestions. Reconsideration and withdrawal of the objections to the Abstract are therefore respectfully requested.

As a second preliminary matter, the Disclosure stands objected to, also for informalities. Similar to the issues raised above, Applicants respectfully traverse a portion of the 36 cited informalities, namely numbers 2-4, 7, 10, 14, 18-19, 28, and 30 as having already been amended in Supplemental Amendment C. Applicants specifically traverse the cited objections of numbers 22-23 and 27, however because these three cited items are not informalities, nor are the portions of claim language cited by the Examiner incorrect, and the objections thereto should be reconsidered and withdrawn. With respect to the remaining cited items, specifically numbers 1, 5-6, 8-9, 11-13, 15-17, 20-21, 24, 26, 29, and 31-36,

Applicants have amended the Specification to the present Application according to the Examiner's suggestions.

With respect to Specification item number 12, however, Applicants point out to the Examiner that only the citation to line 14 of page 6 of the Specification has been amended herein. The remaining 7 citations in item number 12 were all already amended in Supplemental Amendment C. Similarly, with respect to item number 17, only the citation to line 13 of page 7 of the Specification has been amended, because the remaining five citations therein were also amended in Supplemental Amendment C. With respect to item number 25, Applicants had amended this cited informality in Supplemental Amendment C, but with language alternative to the Examiner's proposed correction. Applicants have further amended this cited item herein to remove a portion of the cited phrase which was inadvertently left in the text in Supplemental Amendment C. Applicants therefore submit that all of the Examiner's cited informalities have been fully addressed, and accordingly request reconsideration and withdrawal of the objection to the Disclosure.

As a third preliminary matter, Figs. 3 and 10 of the drawings also stand objected to. Applicants respectfully traverse this rejection for reasons similar to the discussion noted above. The Examiner's cited objections have all been fully addressed and corrected in several previous Letters to the Draftsman. The Examiner's objection to Fig. 3 in particular was already twice corrected in two separate Letters to the Draftsman filed October 7, 2003, and December 4, 2003, respectively. The Examiner's objection to Fig. 10 was also corrected in the same two Letters to the Draftsman, as well as in a third Letter to the

Draftsman, which was filed previously on August 12, 2003. Applicants would also be glad to furnish the Examiner with courtesy copies of any one or all of these Letters to the Draftsman if the Patent Office has misplaced these documents as well. Accordingly, Applicants respectfully request withdrawal of the objection to the drawings.

As a fourth preliminary matter, claims 1 and 8 stand objected to. Specifically, the Examiner asserts that a phrase in claim 1 “does not fit well with the rest of the claim,” and that one instance of the word “selected” should be deleted from claim 8. Applicants agree with the Examiner’s assertion with respect to claim 8. The identified claim term was meant to be deleted with the amendments from Amendment D, filed June 9, 2004, but inadvertently left in the claim. With respect to the Examiner’s objection to claim 1, however, Applicants submit that no amendment is required for the identified claim phrase, but have nevertheless slightly amended this phrase only for grammatical consistency, because such an amendment does not affect the scope the claim. Claims 1 and 8 have otherwise only been amended to correct for typographical and/or other grammatical errors not identified by the Examiner. Accordingly, reconsideration and withdrawal of the objections to the claims are respectfully requested in light of these amendments.

Claims 1, 3, 5-8, 10, and 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tigner (U.S. 6,208,480). Applicants respectfully traverse this rejection, initially because Tigner is not prior art against the present invention. Tigner has a filing date of October 14, 1998, whereas the present invention claims priority to September 25, 1998, which is approximately three weeks earlier than the Tigner reference. Applicants further

traverse this rejection because the Examiner has not established a proper *prima facie* case of obviousness against the present invention.

Specifically, the Examiner expressly acknowledges on page 8 of Paper No. 23, that Tigner does not disclose to calculate the time difference between first and second discrepancy times, as clearly recited in the present invention. The Examiner asserts, however, that the present invention must still somehow be obvious from Tigner because “in effect the disclosure of Tigner *provides the same result* as applicant.” (Emphasis added). Such reasoning though, fails to establish a *prima facie* case of obviousness.

Section 2143.03 of the MPEP specifically requires of the Examiner, when attempting to establish a *prima facie* case of obviousness, to first cite to where in the prior art reference or references each and every feature and limitation of the claimed invention are taught or suggested. In the present case, however, the Examiner has admittedly not satisfied this clear requirement of patent law. The Examiner acknowledges that at least this one specific limitation of the present invention cannot be found within the only cited prior art reference. For at least these reasons therefore, the Section 103 rejection is deficient, and must be withdrawn.

Applicants further submit that the Examiner’s assertion regarding the “same result” between Tigner’s disclosure and Applicant’s, even if correct (for the purposes of this discussion only), is irrelevant to the patentability of this inventions and still would not overcome the clear deficiencies in the obviousness rejection. Similar or same results between different method claims could not establish the grounds for rejecting one method

claim over the other. The Examiner is charged to examine the specific steps claimed by the present invention to reach such results, and not just the end results. Applicants submit that it is a well-established principal of patent law that the specific features and limitations of the recited claims are what determines patentability over the prior art, and not the respective results achieved by such particular steps. According to the Examiner's reasoning therefore, a vast number of already granted patents should have been ineligible for patent protection because they accomplished the same results as previous, albeit different, devices or methods within the same fields of art. Applicants respectfully submit that such a rationale cannot overcome the deficiencies in a reference that admittedly does not teach or suggest all of the claim limitations of the present invention.

Additionally, Applicants even further traverse the rejection because the servo control method identified by the Examiner from Tigner does not present any novel process steps over even the technique disclosed in the present Application as admitted prior art (Fig. 14). Tigner merely discloses a servo control method for a staggered servo format. (See col. 1, lines 54-59; Fig. 2). Tigner further discloses the FRAME COUNTER 540 and the FRAME OFFSET defining the offset of the Ref-SGATE signal from timing mark detection in the servo field by TMD 520. (See col. 5, lines 5-50). According to Tigner, the FRAME OFFSET values vary for each head, but are determined from a base timing of the ref-index which is common to all heads, and also indicates a top of the FRAME PERIOD. (See Figs. 4-9). This method simply does not disclose all of the features of the present invention.

The present invention, on the other hand, more advantageously utilizes a memory (16) that stores discrepancy times between a reference head and each of the other heads, and the switching servo gate timing is then performed by reading  $T_a$  between the reference head and a present head, and  $T_b$  between the reference and a switched head, and then calculating the time difference  $T_d$  between these two times  $T_a$ ,  $T_b$ . The time difference  $T_b$  is then set as the servo gate timing, and head switching time can be significantly reduced over conventional methods, such as those of the admitted prior art, or even Tigner, and a faster head switching is thereby also advantageously enabled. The present invention could therefore not be obvious Tigner, and the Section 103 rejection should be withdrawn for at least these additional reasons as well.

For all of the foregoing reasons, Applicants submit that this Application, including claims 1, 3, 5-8, 10, and 12-14, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.


**Customer No. 24978**

November 22, 2004

300 South Wacker Drive  
Suite 2500  
Chicago, Illinois 60606  
Telephone: (312) 360-0080  
Facsimile: (312) 360-9315

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By

  
Josh C. Snider  
Registration No. 47,954